

REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the Claims in the present Application.

CLAIMS	STATUS	DEPENDENCY
1	Currently Amended	Independent
2	Original	1
3	Original	1
4	Withdrawn	—
5	Withdrawn	—
6	Withdrawn	—
7	Withdrawn	—
8	Withdrawn	—

Comments of Primary Examiner Alicia Ann CHEVALIER have been reviewed carefully along with pertinent sections of the Patent Act, Patent Rules, Manual of Patent Examining Procedures, legal treatises and relevant decisional law. Allowance of the Application, as amended, is solicited earnestly.

Claim 1 has been amended to improve the clarity of the claim language. No new matter has been added. Claim 1 as amended is believed to be patentable.

Claims 1-3 are pending in the Application, Claims 4-8 are withdrawn from

consideration.

Claims 1-3 have been rejected under USC 103(a) as being unpatentable over Huang (US Patent No. 5,571,051) in view of Huang (US Patent No. 6,663,500).

Reconsideration of the Examiner's rejection of Claims 1-3 is requested on the following basis. An examination of the Huang 5,571,051 and Huang 6,663,500 patents reveals the following differences between the structures shown thereon, the structure of the present invention and the statements of the Examiner.

The Examiner has stated:

Regarding Applicant's claim 1, Huang '051 discloses a grip belt (golf club grip, title) comprising a nonwoven fabric base material (felt, Co. 4, line 14) having a plurality of through holes through top and bottom sides thereof (figure 2), an elastic polyurethane cover layer (col. 4, line 4) bonded to the top side of said nonwoven fabric base material (figure 2), a plurality of small air holes formed in the elastic polyurethane cover layer adjacent to the nonwoven fabric base material (figure 2) and a plurality of air cells formed in the elastic polyurethane cover layer within and around the through holes (pores, col. 3, line 53 and figure 12).

Huang '051 fails to disclose that the through holes are filled up the through holes.

Huang '500 discloses an all weather composite grip for golf clubs (title) comprising a felt base material with polyurethane cover layer (col. 3, lines 54-57). The polyurethane covers and impregnates the felt (col. 5, lines 54-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to impregnate the felt with polyurethane as taught by Huang '500 in Huang 051 in order to improve the weatherability of the grip.

Regarding Applicant's claim 2, Huang '051 discloses that the grip belt further comprises a plurality of recessed portions (tread, col. 4, line 34) formed in one side of the elastic polyurethane cover layer opposite to the nonwoven fabric base material corresponding to the through holes (figure 5).

Regarding Applicant's claim 3, Huang '051 discloses that the through holes are formed in the nonwoven fabric base material subject to a predetermined pattern (figure 3).

1. The Examiner is correct in stating that Huang '051 fails to disclose that the through holes are filled as described in the present Application and as claimed in Claim 1.

2. Huang '051 indeed teaches away from filling the through holes in any manner because Huang '051 teaches the "breathing" of air through the grip, col. 4, line 16, and further Huang '051 teaches the evaporation of dampness through the holes when playing under rainy conditions, col. 4, lines 19-22, and Fig. 13 which shows a droplet entering one

of the holes.

3. Fig. 13 of Huang '051 shows clearly that Huang '051 relies on dimples 40 and clear unobstructed perforation 38 to facilitate the passage of droplets of moisture. Huang '051 thus clearly relies on open and unfilled perforations for the desired mode of operation and not on the filled perforations of the present invention. Huang '051 can not accomplish the desired mode of operation shown in fig. 13 if the perforations were filled as in the present invention.

4. The Examiner has stated that it would be obvious "to impregnate the felt with polyurethane as taught by Huang '500 . . .".

Examination of the Huang '500 reference shown that Huang '500 provides a three layer device. As shown clearly in fig. 22, the layers are: a top layer of polyurethane, P2, an intermediate layer of fabric mesh, 85A and 85B, and a bottom layer of felt B2. The specification in col 5, lines 54-56 states that "The thickness of the polyurethane layer should be sufficient to cover and impregnate the fibers of the mesh".

5. Huang '500 does not teach the impregnation of the felt layer.

6. Huang '500 does not show a felt layer having through holes as in the present invention.

7. Huang '500 teaches the use of polyurethane to bond together the felt layer and the mesh, col. 5, lines 58-59. Bonding is a surface phenomenon and as shown in fig. 22 of Huang '500 and as stated in the Huang '500 specification there is no teaching of the flowing of polyurethane into holes formed in a felt layer as in the present invention.

8. Claims 2 and 3 depend from Claim 1 and are believed to be patentable in view of this dependency.

The Huang '501 and Huang '500 references taken individually or together do not lead to the teaching of the present invention.

There is no teaching in the Huang 5,571,051 and Huang 6,663,500 references taken alone or in combination which leads to the structure of the present invention.

For the above reasons the application of the Huang 5,571,051 and Huang 6,663,500 references is not considered to be appropriate.

In a famous footnote in *Hodosh v. Block Drug Co.*, 786 F2d 1136, 229 USPQ 182, 1897 (Fed. Cir., 1986), the Federal Circuit set out five principles, with citations to previous cases, regarding obviousness determinations under Section 103. The footnote (as to the first four principles reads as follows:

Our comments on the district court's obviousness determination generally include

the following tenets of patent law that must be adhered to when applying § 103:

(1) the claimed invention must be considered as a whole (35 USC 103); see, e.g., Jones v. Harty, 727 F. 2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir., 1984) though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

(2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., Lindemann Machinenfabrik GmbH v. American Hoist & Derrick Co., 730 F. 2d 1452, 1462, 220 USPQ 481, 488 (Fed. Cir. 1984)

(3) the references must be viewed without the benefit of hindsight version afforded by the claimed invention (e.g. W.L. Gore & Associates, Inc. v. Garlock, Inc. 721 F 2d 1540, 1553, 220 USPQ 330, 313 (Fed. Cir., 1983));

(4) “ought to be tried” is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220 USPQ at 1026).

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues hereininvolved.

It is submitted that the Examiner's position in applying Huang 5,571,051 and Huang 6,663,500 is contrary to the above-quoted tents of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as a whole, it is self-evident that Applicant's invention is not rendered obvious by the cited prior art, whether considered alone or in combination.

The statutory presumption of 35 USC §282 makes an invention presumptively non-obvious unless the Examiner can demonstrate that "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains," 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of the ordinary skill when the invention was made; and (4) any other objective considerations including evidence of commercial success, copying, and a long-felt need in the industry. Continental Can Co. v. Monsanto Co., 948 F 2d 1264, 1270, 1273 (Fed. Cir. 1991) (citing Graham V. Deere Co., 383 US 1.17 (1966)). The decision maker is not to apply hingsight, but must analyze obviousness from the viewpoint of a person skilled in the art prior to the disclosure of the present invention Panduit Corp. v. Dennis Mfg., Co., 810 F2d 1561, 1566 (Fed. Cir.), cert denied, 481 US 052 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely "icing on the cake". Hybrietch, Inc. v. Monoclonal Antibodies, Inc., 802 F 2d 12367, 1380 (Fed. Cir. 1986), cert denied, 4580 US 974 (1987). The Federal Circuit has stated that:

(i)ndeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant's invention from selecting bits and pieces from Huang 5,571,051 and Huang 6,663,500. The cherry picking exercise is just the sort of hindsight reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggest to a person or ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. Panduit Corp. 810 F 2d at 1568. The prior art existed for many years and yet those skilled in the art never created a grip-belt and its fabrication method comparable to Applicant's. See Id at 1577 (that skilled workers did not create (patented) invention, despite existence of elements in the prior art, is evidence of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weigh strongly in favor of a conclusion that Applicant's invention is not obvious.

Continental Can, 948 F2d at 1273.

The status of the Claims is as follows:

Claim 1 is currently amended.


Claims 2-3 are original.

Claims 4-8 are withdrawn.

In view of the foregoing amendments, submissions and explanations, it is believed that Claims 1-3, as amended, are in condition for allowance. An early Notice of Allowance on the Application will be appreciated.

Courtesy, cooperation and skill of Primary Examiner Alicia Ann CHEVALIER are appreciated and acknowledged.

Respectfully,

A handwritten signature in cursive script, reading "Charles E. Baxley".

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